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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/704,379   | 11/02/2000  | Fred Bishop          | 10655.7600          | 4909             |
| 66170 7590 04/21/2008<br>AMERICAN EXPRESS TRAVEL RELATED SERVICES CO., INC.<br>c/o SNELL & WILMER, L.L.P.<br>ONE ARIZONA CENTER<br>400 E. VAN BUREN STREET<br>PHOENIX, AZ 85004-2202 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| PATEL, JAGDISH   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3693   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
| 04/21/2008   |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

HSOBELMAN@SWLAW.COM  
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### Office Action Summary

**Application No.**

09/704,379

**Applicant(s)**

BISHOP ET AL.

**Examiner**

JAGDISH N. PATEL

**Art Unit**

3693

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-10, 15, 16, 19, 21-25, 38, 53-58 and 61-64 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 2-10, 15, 16, 19, 21-25, 38, 53-58 and 61-64 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to amendment filed 1/11/08.

#### ***Response to Amendment***

2. Claims 6 -10, 19, 21, 25, 38, 53-54, 57 have been amended. Claims 2-10, 15,16, 19, 21-25, 38, 53-58 and 61-64 are currently pending.

#### ***Response to Arguments***

3. Applicant's arguments with respect to the pending amended claims have been considered but are moot in view of the new ground(s) of rejections. The examiner has withdrawn prior art rejections under 35 USC 103(a).

NOTE: the amended method claims refer to "financial account issuer" as a human entity as broadly interpreted. Please clarify the process claims to indicate that the financial account issuer is a processor. This suggestion is to circumvent a potential 35 USC 101 rejection which requires (IN RE STEPHEN W. COMISKEY, United States Court of Appeals for the Federal Circuit) that a process must be implemented in an apparatus to be statutory.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-10, 15,16, 19, 21-25, 38, 53-58 and 61-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The amended independent claims are defective because of the following reasons. These defects render the claimed invention indefinite and hence the claims are rejected under 35 USC 112 (second).

The first receiving step of claim 6 recites receiving a first application for a first account from a first party and that the first application comprises (fields which include) first financial account information (relating to a first account). This step further recites receiving first transaction management information from the first party to facilitate transaction management between the first party and a second party.

The second process step is analyzing at the financial account issuer the received financial account information to determine when the first party is eligible for the first account.

The third process step recites that the first financial account is created for the first party when the first party is eligible for the first account.

[Note that in the second and third process step there is no positive recitation that the first financial account is created. The conditional requirement "when" said first party is eligible for the first account and the term "facilitating" suggests that (a) the process claim provides for creation of the financial account when the first party becomes eligible for the same. Broadly interpreted, the first party may never be eligible and there is no recitation in the claim that specify a determining that the first party indeed becomes eligible based on some criteria or conditions.]

Likewise, the analysis of the first transaction management information also contain similar deficiency as discussed above. The "when" condition suggest that the first party is likely in some future time to become eligible to participate in said transaction management.

The claim fail to specify when and under what specific condition(s) the first party is eligible to (or qualified) for the first financial account and becomes eligible to participate in the transaction management process.

By reviewing the claim further, it can not be determined that the first party is registered with the financial account issuer because the aforementioned conditions may not materialize.

The applicant is suggested to use the aforementioned process in positive limitations for the aforementioned (other similar) process steps. For example,

“determining eligibility of said first participant at said financial account issuer by analyzing said first financial account information and based on said eligibility creating said first financial account for said first party wherein the first financial account includes ....”

Etc. etc.

This is exemplary analysis only and not intended to be exhaustive. However, it is representative of other similar defective limitation in the claim.

The amended claims contain the following additional defects.

The claimed invention is completely silent about the source of the funds associated with the first account. the step of receiving a request to debit the first financial account to effectuate a purchase transaction only specifies the first and second party identifiers and their respective account identifiers but fails to specify an amount of funds that must be debited from the first

account (which it is specified as "a sales price of the item" in the debiting step). The debiting step further refers to "funds from said first financial account". However, it is not specified how the first financial account itself is funded in order to facilitate the debiting. Is the first account linked to a financial institution or is it self funded (pre-loaded)?

The claim recites interfacing the financial account issuer with a shipping agent. However, there is no communication with the shipping agent with respect to the purchase transaction which indicate information regarding the purchased item and the first party and that the funds have been credited to the second financial account.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693